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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,936	05/31/2006	Philip Head	21.1196	2024
23718	7590	02/15/2008	EXAMINER	
SCHLUMBERGER OILFIELD SERVICES			COY, NICOLE A	
200 GILLINGHAM LANE			ART UNIT	PAPER NUMBER
MD 200-9			3672	
SUGAR LAND, TX 77478				
			MAIL DATE	DELIVERY MODE
			02/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/534,936	HEAD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	NICOLE COY	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 May 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6,8-10,12-17,20 and 21 is/are rejected.
- 7) Claim(s) 7,11,18 and 19 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/13/05</u> .   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### ***Specification***

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Method and apparatus for forming a window in a casing using a biasing arm.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-10, 12-17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terrell et al. (USP 4,889,187) in view of Robinson (US 2001/0045282).

With respect to claims 1 and 12, Terrell et al. discloses a method of cutting through a tubular of a wellbore at a selected location in the wellbore using a cutting tool that comprises (a) a tool body (11), (b) a cutting head (149) provided with a cutting means (157), the cutting head being pivotally mounted (via 55) on the tool body at or near the lower end thereof (see figure 1), (d) a biasing means (159), the method comprising the steps of: passing the cutting tool to the selected location in the wellbore with the longitudinal axis of the cutting head aligned with the longitudinal axis of the tool body (see figures 2A-2G); actuating the biasing means to urge the cutting means of the cutting head against the wall of the tubular (see column 7 lines 28-42); and actuating the cutting means to cut through the tubular of the wellbore (see column 7 lines 9-27), wherein the biasing means is an elongate arm (159) that is an extension of the cutting head, said arm being moveable between a retracted position where said elongate arm lies within a longitudinal recess in the tool body and an extended position (see figure 2G). Terrell et al. does not disclose electrically actuating the pivoting means.

With respect to claims 2 and 13, Terrell et al. disclose the tool body is provided with a transversely extending fulcrum (55) which pivotally supports the cutting head and the pivoting means pivots the cutting head about the transversely extending fulcrum to a position where the cutting means of the cutting head is adjacent the wall of the tubular.

With respect to claim 3, Terrell et al. discloses the tubular is a casing (15) of a wellbore.

With respect to claim 4, Terrell et al. discloses the cutting tool is passed to the selected location in the wellbore through the production tubing (see figure 1).

With respect to claim 5, Terrell et al. discloses that the cutting tool is passed to the selected location in the wellbore with the elongate arm in its retracted position and actuation of the means for pivoting the cutting head causes the elongate arm to pivot outwardly with respect to the tool body to its extended position to engage the wall of the tubular at a position opposite to the cutting means (see figure 2G).

With respect to claims 6 and 17, Terrell et al. discloses the elongate arm is provided with traction means (wherein the end of 159 would have traction means) at the location where the arm engages the wall of the tubular.

With respect to claim 8, Terrell et al. discloses the cutting tool is passed to the selected location in the wellbore suspended from a cable (13).

With respect to claim 9, Terrell et al. disclose the cutting tool further comprises an anchoring means (47) and the tool is locked in place at the selected location in the wellbore by setting the anchoring means prior to actuating the pivoting means.

With respect to claims 10, 16, and 21, Terrell et al. discloses that the cutter is rotated, but does not disclose rotating with a stepper motor. The Examiner hereby takes Official Notice that it is well known to rotate a tool downhole with an electric motor. It would have been obvious to one having ordinary skill in the art at the time of the invention to use an electric motor with the invention of Terrell et al. in order to rotate the cutting head.

With respect to claim 14, Terrell et al. disclose the tool body is provided with a releasable connector (19) for a cable (13), coiled tubing or electric drill string.

With respect to claim 15, Terrell et al. disclose that the cutting tool (11) is provided with an anchoring means (47) for locking the tool in place in a wellbore.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Terrell et al. in view of Robinson in further view of Bailey.

With respect to claim 20, Terrell et al. in view of Robinson does not disclose a guide means suspended from the tool. Bailey discloses suspending a whipstock from a milling tool in order to guide drilling devices into the lateral borehole. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Terrell et al. in view of Robinson by including a whipstock attached to the end of the drilling assembly in order to guide a drilling device into the lateral borehole.

***Allowable Subject Matter***

6. Claims 7, 11, 18, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE COY whose telephone number is (571)272-5405. The examiner can normally be reached on M-F 7:30-5:00, 1st F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

//William P Neuder//  
Primary Examiner, Art Unit 3672

nac